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BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER PANNALA, SATHYANARAYA R	
			ART UNIT	PAPER NUMBER
			2164	
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			07/11/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/721,639

Applicant(s)

HARVEY, RICHARD HANS

Examiner

Sathyanarayan Pannala

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 11, 12 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11, 12 and 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's Amendment filed on 10/31/2007 has been entered with amended claims 1, 11, 17-22 and it is in response to the Office Action mailed on 1/29/2008. In this Office Action claims 1-5, 11-12 and 15-22 are pending.

Claim Objections

2. Claims 1-5 are objected, because none of the claims are directed to statutory subject matter. Independent claim 1 deals with simple abstract idea of determining whether an instruction or operation and the steps of these claims are non-patentable. A claim that recites a computer that solely calculates a mathematical formula or a computer disk that solely stores a mathematical formula is not directed to the type of statutory subject matter eligible for patent protection. The claims are not producing useful, concrete and tangible results. See *Diehr*, 450 U.S. at 186 and *Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972). In *Sarkar*, 588 F.2d at 1335, 200 USPQ at 139. See recent court case, *In-Re Comiskey*, __ Fed. Cir, 2007__ decided 9/20/2007. (see MPEP 2106(IV)(B)(2)(b)(ii)).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 11 and 17-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1 and 11 are phrased as "an initial information entry identifier". Applicant cited as page 3, line 27- page 4, line 2; page 9, lines 8-11 and lines 19-20. None of these citations support the claimed phrase. Again, Applicant is misinterpreting the specification and a thorough grasping of the cited reference is required.

5. Claims 11-12, 16, 18, 20 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant added the

new subject matter as "computer-readable medium" which is not supported by the specification or the drawing.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 11 and 17-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, page 2, line 8, claiming as "an initial information entry identifier" whereas the specification silent about it. Similarly claim 11, is claiming. More clarification is required.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 11-12, 16, 18, 20 and 22 are rejected under 35 U.S.C. § 101, because none of the claims are directed to statutory subject matter. Independent claim 11 and the steps of this claim are non-patentable as it is software per se. A claim that recites a computer that solely calculates a mathematical formula or a computer disk that solely

stores a mathematical formula is not directed to the type of statutory subject matter eligible for patent protection. Claims 12, 16, 18 and 22 are being dependent directly or indirectly on claim 11 and therefore, they are also rejected under the same reason. See *Diehr*, 450 U.S. at 186 and *Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972). In *Sarkar*, 588 F.2d at 1335, 200 USPQ at 139. See recent court case, *In-Re Comiskey*, __, Fed. Cir., 2007_ decided 9/20/2007. (see MPEP 2106(IV)(B)(2)(b)(ii)).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-5 and 11-12 and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Bachmann et al.* (US Patent 6,085,188) hereinafter *Bachmann*, and in view of *Byrne et al.* (US Patent 6,347,312) hereinafter *Byrne*.

12. *Bachmann* teaches independent claims 1, 11 by the following: determining whether an instruction or operation adds an information entry or removes information

entry from a database system, for an add operation, the information entry is first added to an 'out' table, and wherein for a remove operation, the information entry is first removed from an 'in' table (Fig. 7-8, col. 6, line 47 to col. 7, line 15). Bachmann teaches the parent table and child table, which is analogous to using two tables of in and out and explicitly does not teach the in and out tables. However, Byrne teaches two tables which are similar to the purpose of in and out tables as Type I cache (40) and Type II cache (42). Type I is for a set of identifiers which qualify for a given LDAP search query of a particular filter key and the unit is indexed by that filter key. This way the repetitive search queries are handled without resort to the relational database (38). A record for Type I is the same as the in table. Whereas Type II cache maintains results of the query (Byrne, Fig. 5, col. 5, line 50 to col. 6, lines 11). The search is done first and the data is filled into Type II and then search query in Type I one will be retained. When the search query did not find the record, the query will not be retained in the Type I and the result will not be available to store in the Type II. Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to combine teaching of the cited references because Byrne's teachings would have allowed Bachmann's method would have been efficient of handling of repetitive searches issued from a hierarchical directory service to a relational database backing store (Byrne, col. 2, lines 22-25).

Bachmann teaches the claimed, employing the instruction or operation to amend the information entry in the database system (Fig. 8, col. 6, lines 60-64).

Additionally, Examiner has experience in using Sybase database system. Sybase database uses out-table and in-table. These tables are system tables and every database system uses similar system tables. In case of Sybase, these tables could be accessed or seen by the system user. An application controlling the process creates a record in out-table and the system monitors the presence of records. The system disposes of the records in the in-table as they are acted upon as well as from out-table. When the system non-invasively monitors processes, an external application such as the application controlling the process disposes of the records as they are acted upon.

Bachmann teaches the claimed, the 'in' table provides, during a search, an initial information entry identifier, and the 'out' table provides a result of the search using the initial information entry identifier (Fig. 7-8, col. 6, line 47 to col. 7, line 15).

13. As per dependent claim 2, Bachmann teaches "the information is added to the 'in' table after being added to the 'out' table" (Fig. 8, col. 6, line 60 to col. 7, line 15).

14. As per dependent claim 3, Bachmann teaches "the information is removed from the 'out' table after being removed from the 'in' table" (Fig. 7, col. 6, lines 47-59).

15. As per dependent claim 4, Bachmann teaches "performing one entry operation of the plurality of add and remove entry operations if the instruction or operation is

determining whether the instruction modify entry information" (Fig. 8, col. 5, lines 60-67, col. 6, lines 60-67).

16. As per dependent claims 5, 12, Bachmann teaches claimed "the instructions are implemented via a directory system such as X.500 or LDAP" (Fig. 4A-C, col. 4, lines 22-35).

17. As per dependent claims 15, 16 Bachmann teaches the claimed "using the out table to retrieve a result of the search of the in table." (Fig. 8, col. 6, line 60 to col. 7, line 15).

18. As per dependent claims 17-18, Bachmann teaches the claimed, preventing the amended information entry from being searchable until at least the 'in' table includes the amended information entry (Fig. 7-8, col. 6, line 47 to col. 7, line 15).

19. As per dependent claims 19-20, Bachmann teaches the claimed, only the amended information entry is prevented from being searchable until at least the 'in' table includes the amended information entry (Fig. 7-8, col. 6, line 47 to col. 7, line 15).

20. As per dependent claims 21-22, Bachmann teaches the claimed, preventing the amended information entry from being searchable until at least the 'in' table includes the amended information entry comprises making the amended information entry non-

visible until at least the 'in' table includes the amended information entry (Fig. 7-8, col. 6, line 47 to col. 7, line 15).

Response to Arguments

21. Applicant's arguments filed on 4/15/2008 with respect claims 1-5, 11-12 and 15-22 have been fully considered but they are not persuasive and the details as follows:

a) Applicant's argument regarding claims rejection under 35 U.S.C. § 101, states as "The Examiner rejects Claims 1-5, 11-12, and 15-22 under 35 U.S.C. § 101, stating that the claims deals with an abstract idea."

In response to Applicant's argument, Examiner respectfully disagrees with Applicant. Because, the method claims 1-5, 15, 17, 19, 21 are now objected because they deals with an abstract idea and the system claims 11-12, 16, 18, 20, 22 are rejected under software per se.

b) Applicant's argument regarding claims rejection under 35 U.S.C. § 112, 1st and 2nd paragraphs, states that Applicant has amended Claims 1 and 11 to remove the rejected limitation "preventing the amended information entry from being searchable until at least the 'in' table includes amended information entry," rendering these rejections moot.

In response to Applicant's argument, Examiner respectfully disagrees with Applicant. Because, Applicant again tried to do similar way and he did not grasp

thoroughly the cited specification and amended the claims different from the specification.

c) Applicant's argument regarding claims rejection under 35 U.S.C. § 103, states as "neither Bachmann nor Byrne disclose "preventing the amended information entry from being searchable until at least the 'in' table includes the amended information entry" of Claim 1."

In response to Applicant's argument, Examiner respectfully disagrees with the applicant. Because Bachmann and Byrne combined do teach all limitations of claims 1 and 11 and for details, see under Claims Rejection under 103 section.

Conclusion

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sathyanarayan Pannala/
Primary Examiner

srp
July 10, 2008